

No. 20740

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

R. A. HENDERSON,

Appellant,

vs.

A. C. SPARK PLUG DIVISION,
GENERAL MOTORS CORPORATION,

Appellee.

APPELLEE'S BRIEF

LYON & LYON

RICHARD E. LYON

811 West Seventh Street

Los Angeles, California 90017

Attorneys for Appellee

Of Counsel:

J. L. CARPENTER

General Motors Corporation

3044 West Grand Boulevard

Detroit, Michigan 48202

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APPELLEE'S BRIEF

JURISDICTIONAL STATEMENT

To fully inform this Court as to the basis for its jurisdiction and to comply with Rule 18(b) of this Court, plaintiff-appellant's* jurisdictional statement (Appellant's Br. 1-2) should have included the following. The instant appeals arise out of two actions brought by plaintiff for patent infringement against appellees General Motors Corporation** and Ford Motor Company. These actions were based upon two amended complaints filed October 26, 1964 against defendant GM (R. 2) and against Ford (R. 41). Answers to these complaints were duly filed by each defendant (R. 5, 44). After various proceedings not material to this appeal each of the defendants filed a motion for summary judgment

* Hereinafter termed plaintiff.

** Hereinafter termed defendant GM.

(R. 30, 49). These motions were granted and on November 30, 1965, judgments of dismissal were entered as to each defendant (R. 12, 37). Findings of Fact and Conclusions of Law were entered on the same day in each action (R. 13, 81). On December 27, 1965, an order was entered granting plaintiff leave to appeal in forma pauperis (R. 34).

STATEMENT OF THE CASE

Plaintiff's statement of the case (Appellant's Br. 2-4) also fails to comply with Rule 18(c) of this Court in that it is argumentative, incomplete and inaccurate. Accordingly, defendant GM will herein set forth its own statement of the case.

A. Proceedings Below

The action is for patent infringement, plaintiff alleging in its amended complaint infringement by defendant GM of Henderson Patent No. 3,088,477, entitled "Control for Automotive Exhaust Air Pollution" which issued May 7, 1963, to plaintiff and to various other partial owners noted on the patent document (R. 64). In its answer (R. 5) defendant GM denied infringement and asserted *inter alia* that the patent was invalid on two grounds. These are (1) that the patent is anticipated by prior art and (2) that the alleged invention purported to be patented was in public use and on sale in this country more than one year prior to the filing date of the application on which the patent issued. On July 14, 1965, the District Court entered a partial summary judgment that defendant GM had not infringed claims 1 through 5 of the patent (R. 14). No appeal has been taken as to this and the

instant appeal involves only claim 6, the single remaining claim of the patent.

On October 29, 1965, defendant GM filed its motion for summary judgment that claim 6 is invalid (R. 31). This motion presented the two defenses of anticipation and prior use and sale noted above. In support of this motion, defendant GM filed a detailed affidavit by Alfred E. Majewski one of its senior project engineers (R. 20) together with a number of supporting exhibits to such affidavit.*

The matter was heard by the District Court on November 8, 1965.** In such hearing, oral testimony was given by Earl F. Kotts, who was called as the court's expert (R. 8) and John L. Neill, a witness called on behalf of appellant (R. 25).

As set forth in its Findings of Fact and Conclusions of Law (R. 13-18), the District Court sustained both the defense of anticipation and that of prior use and sale. Thus, in its Conclusions of Law the court stated that claim 6 was invalid as anticipated by the earlier Hanks Patent No. 2,354,373 (C.L. III R. 18) and invalid because the device of defendant GM which was charged to infringe claim 6 had been in public use and on sale more than one year before the filing date of the patent (C.L. IV R. 18).

* For the convenience of the Court, Exhibits AA and NN to the Majewski affidavit are included as an appendix to this brief.

** The transcript of this hearing is included in the Transcript of Record and will be referred to herein as (Nov. 8 Tr.).

The action has had one unique aspect to which this Court's attention should be drawn. As shown by the Amended Complaint (R. 2) the action was brought in *propria persona*. In order to insure that the interests of plaintiff were fully protected at all stages in the proceedings, the court of its own motion appointed an attorney Charles E. Karpinski to act on behalf of the plaintiff (Nov. 8 Tr. 3), and also appointed its own expert, Mr. Earl F. Kotts (Nov. 8 Tr. 8).

B. The Patent in Suit

The Henderson patent in suit (R. 64) is directed to a system which has long been known in the trade as a "positive crankcase ventilation system." In such a system, crankcase vapors are fed back to the intake manifold of the engine through a flow-control valve. This system differs from that most commonly used in passenger automobiles wherein crankcase vapors are permitted to escape to atmosphere through a road draft tube (F.F. III R. 14). The Henderson patent describes such a system including the normal components which have been in use for years. These are a hose or a pipe, a flow-control valve, appropriate connectors and an adaptor plate for insertion between the carburetor and the intake manifold of the engine. To this combination of usual components, the patent in suit describes the addition of an adjustable needle valve at the entrance to the intake manifold and heating means in the adaptor to heat the fed back crankcase vapors. It is the addition of the heating means that claim 6 of the patent purports to cover (F.F. IV R. 14). The combination of elements specified in claim 6 is readily apparent

in the color-coded chart comprising Exhibit AA to the Majewski affidavit (R. 20).

The patent in suit recites (R. 68) that it is a continuation-in-part of U. S. Application Serial No. 86,565.

C. The Abandoned Application

On January 25, 1961, plaintiff caused to be filed in the United States Patent Office an application for patent entitled "Control Automotive Exhaust Air Pollution". The complete File Wrapper and Contents of this application constitute Ex. No. 1 of the Record. As appears in Ex. 1, the application was rejected by the Patent Office on the ground that the disclosure contained therein was such that the Examiner could not understand it sufficiently to act on the merits (Ex. 1 p. 15-17). The application was then abandoned by plaintiff without any attempt to explain or amend it.

D. Defendant's Device

In 1959 it was discovered in the research laboratories of defendant GM that blow-by fumes from crankcases of automobiles were a substantial contributing factor to the formation of smog (R. 23). Following this discovery defendant GM developed a positive crankcase ventilation system to transmit crankcase gases to the intake manifold rather than exhaust such gases to atmosphere (R. 24). This system is shown in Majewski affidavit Exhibit AA and has been regularly and continuously manufactured, used and sold as a part of Cadillac production from September of 1960 to date (R. 27).

With one exception, the application of the elements of claim 6 of the patent in suit to defendant GM's device is also shown in Exhibit AA. This exception involves the so-called "heating means" comprising the final element of the claim. Defendant GM has denied infringement of this claim on the ground that its device does not include the required heating means and preserves this defense. For the purpose of its motion for summary judgment only, however, defendant GM has conceded that infringement exists and that the passages (color coded brown on Ex. AA) through the adaptor plate (color coded yellow) comprise the specified heating means.

E. The Prior Hanks Patent No. 2,354,373

This patent (Tr. 72) which issued in July, 1944, describes a positive crankcase ventilation system wherein crankcase gases are fed to the intake manifold. Hanks device is shown in Exhibit NN to the Majewski affidavit (Tr. 29). Also shown on this Exhibit is the application of the elements of claim 6 of the patent in suit to the Hanks structure.

F. Plaintiff's Specification of Errors

It is difficult for defendant GM to present a concise brief on this appeal because of plaintiff's failure to specify the error or errors of the court below on which it relies. Thus, on page 6 of its brief plaintiff merely asserts that the District Court erred in holding that the pleadings and testimony did not raise any genuine issue on any material fact. In this, plaintiff makes no attempt to comply with Rule 18(d) of this Court which requires an appellant to

“set out separately and particularly each error intended to be urged.”

Moreover, Rule 18(d) also provides:

“In all cases, when findings are specified as error, the specifications shall state as particularly as may be wherein the findings of fact and conclusions of law are alleged to be erroneous.”

In entering its summary judgment in this case, the District Court made extensive findings of fact and conclusions of law concerning the two defenses presented. Plaintiff has not contested these findings or conclusions.

SUMMARY OF ARGUMENT

A. Prior Use and Sale

Defendant GM's accused structure was on sale and in public use more than a year prior to the filing date of plaintiff's application for patent. Claim 6 is therefore invalid under the prior public use and sale provision of Title 35 U.S.C. Section 102(b).

B. Anticipation

Claim 6 of the patent in suit is invalid as anticipated by the positive crankcase ventilation system disclosed in the earlier patent to Hanks No. 2,354,373. The claim is therefore invalid under the printed publication provision of Title 35 U.S.C. Section 102(b).

C. Absence of Genuine Issue as to Any Material Fact

There is no single fact material to either of the two defenses concerning which there is any honest dispute.

Accordingly, summary judgment was properly granted under Rule 56 of the Federal Rules of Civil Procedure.

ARGUMENT

Introduction

As previously noted, plaintiff has made no effort to comply with Rule 18 of this Court in that it has failed to separately and particularly set out each error intended to be urged. For this reason alone the judgment of the District Court should be affirmed.

Additionally, in its findings of fact and conclusions of law (R. 13-18), the court below found with respect to the defense of prior use and sale that the defendant GM commenced the manufacture and sale of devices charged by plaintiff to infringe the patent in suit in September 1960 and has continuously manufactured and sold such devices since that time (F.F. XII R. 17), that the purported invention of claim 6 of the patent in suit is not described in plaintiff's earlier application Serial No. 86,565 (F.F. VI R. 15), that the earliest filing date which can be accorded the patent in suit is December 5, 1961 (C.L. II R. 18) and that the devices charged to infringe claim 6 have been in public use and on sale more than one year before the filing date of the patent and accordingly claim 6 is invalid (C.L. IV R. 18).

As to the defense of anticipation by the Hanks patent, the court found that each of the elements of claim 6 of the patent in suit is found in the same combination in the Hanks patent which issued many years before the filing date of the patent in suit (F.F. X R. 17) and that claim 6 of the patent in suit is anticipated by Hanks and

is invalid under Title 35 U.S.C. Section 102(b), (C.L. III R. 18).

These findings and conclusions are sufficient in all respects to sustain both defenses urged by defendant GM. They have not been contested by plaintiff nor has plaintiff even suggested that they are in error. These uncontested findings and conclusions in and of themselves provide ample bases for affirming the judgment below.

Faced only with the plaintiff's general assertion that the District Court erred in holding that the pleadings and testimony did not raise any genuine issue on any material fact (Appellant's Br. 6) defendant GM can do no more in this brief than point out wherein the material facts in support of its defenses are established in the Record and the failure by plaintiff to dispute such facts.

A. Prior Use and Sale

Title 35 U.S.C. Section 102(b) reads in part:

Sec. 102. Conditions for patentability; novelty and
loss of right to patent

A person shall be entitled to a patent unless —

.

(b) the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, . . .

As shown on the face of the patent (R. 68) the application for the Henderson patent in suit was filed December 5, 1961. Hence, the critical date for a statutory bar is December 5, 1960. Defendant GM through its Cadil-

lac Motor Car Division, introduced its positive crankcase ventilation system on the market in September, 1960, and has manufactured and sold the same continuously since that date. This is established by the Majewski affidavit (R. 20), particularly paragraphs (3) through (12) thereof (R. 23-27), and fully documented by Exhibits DD, EE, FF, GG, HH, II, JJ, KK, LL and MM to the Majewski affidavit.

These facts stand on the record without contradiction. Indeed, even in his brief plaintiff does not question them.*

The only argument advanced by plaintiff against the defense of statutory bar concerns plaintiff's earlier abandoned application Serial No. 86,565 which was filed January 25, 1961 (Exhibit 1). The patent in suit recites that it is a continuation-in-part of this earlier application and defendant GM concedes that if the combination covered by claim 6 of the patent in suit is adequately described in the earlier application, then the patent would be entitled to the filing date of the earlier application and the use and sale by defendant GM of its device would not be sufficiently early to invalidate the patent. Defendant submits, however, that the Record is clear to the effect that the earlier application does not contain such

* Plaintiff appears to be presenting some kind of argument on this at the bottom of page 12 of his brief wherein the statement is made that the "court is assuming that the alleged infringing device is 'the invention' . . .". If it is plaintiff's position that defendant GM's earlier sales do not invalidate claim 6 because the devices sold do not embody the invention sought to be covered by claim 6 then plaintiff's case must fail for lack of infringement. See *Anderson v. Miller et al* (U.S. 1888) 129 U.S. 70, 32 L.Ed. 635.

a disclosure and further that there is no genuine issue of fact on the point. Significantly, plaintiff makes no effort to show wherein his abandoned application does in fact contain an adequate disclosure. Indeed, he fails to take a position on or even argue the point. To the contrary he carefully states only that a trial is needed to determine the matter (Appellant's Br. 13).

A simple reading of the abandoned application demonstrates its inadequacy to support claim 6.* For example, two of the elements of the combination of claim 6 are:

“a pipe connecting said inlet port with said crankcase to conduct crank case vapors into said opening;

“a flow control valve in said pipe operable by engine induced vacuum to control flow of crankcase vapors according to engine speed”

As shown on Exhibit AA to the Majewski affidavit (R. 20) the specified flow-control valve in the patent in suit is the valve generally indicated by the numeral 16 in Figs. 1 and 2 of the patent which is color coded orange. Referring to the abandoned application and particularly line 17 of page No. 2 of the File Wrapper (Ex. 1), the text specifies:

“14, 14A, 14C is a connection on unit to allow the crankcase breather line to be attached.”

* The sufficiency of a disclosure in a patent application is a question of law. *Minnesota Mining and Mfg. Co. v. Carborundum Co.* (C.A. 3, 1946) 155 F.2d 746, and the construction of the specification and claims is proper on summary judgment. *Milcor Steel Co. v. George A. Fuller Co.* (U.S. 1941) 316 U.S. 143, 86 L.Ed. 1332; *Riley v. Broadway-Hale Stores* (C.A. 9, 1954) 217 F.2d 530; *Bulldog Electric Products Co. v. Cole Electric Products Co.* (C.A. 2, 1945) 148 F.2d 792.

Fig. 1 of the abandoned application (File Wrapper p. 6) shows merely a hose or pipe connected to the element labeled 14. Nowhere is there described or illustrated the flow-control valve required by the claim. To support a claim, the specification must of course describe each of the elements of the claim. *Schriber-Schroth Co. v. Cleveland Trust Co.* (U.S. 1938) 305 U.S. 47, 83 L.Ed. 34.

A further deficiency in the abandoned application is apparent on its face. Thus, the specification borders upon incoherency and it is impossible to ascertain just what the applicant had in mind. In this he failed to present to the Patent Office such an understandable description of his invention as would entitle him to the benefit of his earlier filing date. The legal requirement is set forth in the following language of the Court of Customs and Patent Appeals in *Application of Moreton* (1963) 312 F.2d 954 at 957:

“Our decision as to whether the board was correct in finding that the claimed invention was not entitled to the benefit of the filing date of appellant’s application Serial No. 28,521 requires a careful analysis of that earlier application as a whole to see what invention is disclosed therein. 35 U.S.C. Sec. 120 states that ‘An application for patent for an *invention* disclosed . . . in an application previously filed in the United States by the same inventor shall have the same effect, *as to such invention*, as though filed on the date of the prior application, . . . ’ [Emphasis ours.] If appellant’s invention as claimed in the appealed claims is not disclosed in Serial No. 28,521 he is obviously not entitled to the filing date of that application for the appealed claims.”

The required disclosure is, of course, statutory. Title 35 U.S.C. Section 112 provides:

“The specification shall contain a written description of the invention in such full, clear, concise and exact terms as to enable any person skilled in the art . . . to make and use the same . . . ”

This statutory requirement has not been met. Indeed, the application was rejected by the Patent Office for the precise reason that the disclosure was of such nature that it could not be understood. Thus, at the top of page 16 of the File Wrapper (Exhibit 1) the Patent Office Examiner stated:

“Applicant’s disclosure is such that it cannot be sufficiently understood to enable the examiner to act on the merits.”

The Examiner then proceeded to point out certain physical impossibilities, omissions of necessary description and inconsistencies appearing in the description. On page 17, the following statement appears:

“Claims 1 to 7 are rejected as failing to define the invention since the device is not understood as explained above.”

As shown in the File Wrapper, plaintiff made no effort to contest the Patent Office Examiner in this regard. He presented no arguments nor did he attempt to explain the deficiencies noted. To the contrary, he simply acquiesced in the ruling of the Patent Office and permitted the application to become abandoned.

Mr. Kotts, the court appointed expert, agreed with the position taken by the Patent Office Examiner (Nov. 8 Tr. 12).*

Were there any doubt in the matter, and defendant GM submits that there is not, it would be resolved by the concession by plaintiff made in open court in the course of the November 8 hearing. Thus, the plaintiff, Mr. Henderson, stated:

“According to Congressman Trimble, who originally filed the application that the Commissioner did not understand for my protection while I was in the hospital, *we were aware that the patent was not put together so the Commissioner would understand it*. We were working on the basis that if you filed, you have a six month period to protect your right. (Emphasis added)” (Nov 8 Tr. 19-20).

Summarizing the above, the abandoned application is deficient because it does not include any description or reference to a flow-control valve required by claim 6 of the patent in suit. Further, the application fails to include an adequate description as required by statute. As to this, the Patent Office rejected the application on the ground that it could not be understood. Plaintiff acquiesced in this rejection and permitted the application to become abandoned. Finally, plaintiff has conceded

* It is defendant GM's position that a consideration of the oral testimony given at the November 8 hearing is unnecessary on this appeal because the two defenses involved are conclusively established by the documentary proofs of Record. Occasional reference will, however, be made to such testimony because it has been relied upon by plaintiff in his brief.

his awareness that the application as filed was not expected to be understood.

On page 13 of his brief plaintiff makes the remarkable statement that there is “admittedly an issue of fact” on the question. He reaches this conclusion from the statement of Mr. Kotts that if there was an adequate disclosure in plaintiff’s abandoned application he is entitled to the benefit of its filing date. This is merely a general statement of the law with which the defendant GM has no quarrel. It most certainly does not, however, spell out any *issue of fact* nor has plaintiff suggested what this issue might be.

A review of the Record demonstrates that plaintiff has never made any attempt whatever to show that there was any factual dispute or issue concerning the insufficiency of the disclosure in his abandoned application. To the contrary, as pointed out above, he conceded such insufficiency.

In its motion for summary judgment defendant GM urged that claim 6 was invalid because the alleged invention sought to be covered thereby was in public use and on sale in this country more than one year prior to the date of the application for the patent (R. 31). The evidence establishing this public use and sale is set forth in detail in the affidavit of Majewski and the exhibits attached thereto filed with defendant GM’s motion (R. 20). Plaintiff filed no counter affidavits or memorandum. Plaintiff did not argue in the court below that he was entitled to the filing date of his abandoned application nor did he at any time even suggest that his abandoned application contained a sufficient disclosure. To the contrary, plaintiff’s attorney merely suggested to the court

that it was faced with the factual determination as to whether the application for the patent was or was not a proper continuation-in-part of the abandoned application (Nov. 8 Tr. 50). He made no attempt to point out nor did he suggest that there was a factual *dispute* in the matter. Plaintiff's witness Neill was given a copy of the abandoned application by the court (Nov. 8 Tr. 24). Although questioned at length by plaintiff's counsel on the question of anticipation by the Hanks patent, Neill was not even asked about the sufficiency of the disclosure of the application.

In the brief filed by plaintiff in this Court no attempt has been made to show that plaintiff's abandoned application contains a description of the elements required by claim 6 of the patent in suit. Nor is any argument advanced to show that the description in the application is sufficiently understandable to comply with the statutory requirements.

No dispute or issue has been presented as to any fact material to the question of the insufficiency of the description in plaintiff's abandoned application. Plaintiff's suggestion, and it is no more than that, that there *might* be such an issue cannot fill this void. Accordingly, there is no material issue of fact concerning the defense of prior use and sale and the judgment should be affirmed on this ground.

B. Anticipation by the Hanks Patent

Title 35 U.S.C. Section 102 reads in part:

Sec. 102. Conditions for patentability; novelty
and loss of right to patent

A person shall be entitled to a patent unless —
.

(b) the invention was patented or described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States, . . .

Each of the elements of claim 6 of the patent in suit is found in the earlier Hanks patent. The claim is therefore invalid as anticipated. As stated in *William Carlton, et al v. Howard Bokee* (U.S. 1872) 84 U.S. 463, 21 L.Ed. 517,519:

“Everything here claimed is found in (a prior device) . . . It follows that this claim is void for this reason, without reference to the other objections which have been suggested in relation to it.”

See also *Stallman v. Casey Bearing Company* (C.A. 9, 1957) 244 F.2d 905.

Hanks Patent No. 2,354,373 (R. 72-76) is described in detail in the Majewski affidavit (R. 20) and also in the affidavit of John J. Roethel submitted on behalf of defendant Ford Motor Company (R. 78). These affiants were in agreement that the Hanks patent anticipates claim 6 of the Henderson patent in suit in that each of the elements included in claim 6 is found in the Hanks patent. This anticipation is clearly shown in the color-coded chart appearing as Exhibit NN to the Majewski affidavit. In this chart, claim 6 is dissected into its several elements and the presence of each element in the device in the Hanks patent is shown.

Mr. Kotts, the court appointed expert, agreed in full with the affiants Majewski and Roethel. Thus, Mr. Kotts

testified that all of the elements of Henderson claim 6 are present in the Hanks patent and that the Henderson patent was therefore invalid as anticipated (Nov. 8 Tr. 8). Mr. Kotts further testified:

“THE COURT: Is this, in your opinion, fairly clear from the reading of the Hanks patent and the Henderson patent?

“MR. KOTTS: Yes, it is.

“THE COURT: Anything complicated about it that would require the testimony of any expert on the matter?

“MR. KOTTS: I don't think so. I think the devices are simple enough that you can compare the documents on the basis of anticipation and find Hanks a valid anticipation. (Nov. 8 Tr. 14-15)”

Thus, three experts have reviewed the Hanks patent and are in agreement that it anticipates claim 6 of the patent in suit. Moreover, one of these, a completely unbiased expert, has testified that the devices are simple, that the anticipation appears from a comparison of the documents, and that there is nothing complicated about the matter that would require the testimony of an expert.

While plaintiff argues that issues of fact are involved, he has filed no counter affidavits to establish any dispute as to the basic facts upon which this defense of anticipation is based, nor, as noted above, has he contested any of the court's findings of fact or conclusions of law regarding anticipation.

Disregarding plaintiff's rather lengthy argument in his brief as to the factual questions which can arise in

patent infringement actions on the issue of obviousness* plaintiff's brief contains only three direct references to the question of anticipation by Hanks. First plaintiff makes the general statement that Mr. Neill, plaintiff's expert, testified as to numerous factual distinctions between the Hanks patent and the Henderson patent (Appellant's Br. 3). In support of this plaintiff simply cites pages 25 to 50 of the November 8 transcript which includes the entire testimony given by Neill and does not aid in an identification of the "factual distinctions" which plaintiff has in mind.

As to this, plaintiff gives one specific reference to page 46, lines 11 and 12 of the transcript (Appellant's Br. 3) with the statement that at least as to one feature the Henderson device was described as exactly opposite that of the Hanks device. The matter involved is in no way material. Neill testified that the Hanks flow-control valve operated in the opposite manner to that of Henderson (Nov. 8 Tr. 46). While Neill was incorrect in this statement, the matter is of no moment. Claim 6 simply calls for a flow-control valve operable by engine induced vacuum. It does not require that the valve operate in any particular direction or manner. Thus, the "issue" suggested by plaintiff is not a material one. Similarly, but in more general terms, plaintiff argues that there are differences between the device described in the patent in suit and that of the Hanks patent. Any such differences are, of course, immaterial as to the validity of claim 6 unless these differences are set forth in the claim. See *Winslow*

* An issue which was not considered by the court below and which is not before this Court in the instant appeal.

Engineering Company v. Smith (C.A. 9, 1955) 223 F.2d 438 (adhered to on rehearing, 228 F.2d 332).

Next, plaintiff states (Appellant's Br. 3) that Mr. Henderson gave direct testimony on the factual differences between his device and the earlier Hanks device and refers to page 22, lines 15 through 25 of the November 8 transcript. Plaintiff's characterization of this portion of the Record as "direct testimony" is very misleading. Mr. Henderson had not been sworn as a witness nor was he on the stand. To the contrary, the court had simply asked Mr. Henderson if he had any questions to put to Mr. Kotts the court's expert who was then on the stand (Nov. 8 Tr. 19). Rather than questioning Kotts, Mr. Henderson proceeded simply to argue his cause. This fact was noted by the court (Nov. 8 Tr. 24).

The full statement referred to, commencing on page 21 and continuing through page 24 of the transcript, shows that what Mr. Henderson was really arguing was that his device differed from Hanks in that he utilized a catalyst and screens and that these elements were not shown by Hanks. Both the court and Kotts pointed out to him that claim 6 contains no reference to either screens or a catalyst and therefore his argument had no relevancy on the question of anticipation.

Finally, plaintiff makes the general and unsupported statement that Kotts and Neill testified oppositely as to the fact of anticipation and that the issue is genuine and material (Appellant's Br. 12). This statement does not aid this Court or defendant GM as to just what material factual issue is in dispute.

Because of plaintiff's failure to indicate those portions of Neill's testimony on which it relies, or to specify the particular material facts which it contends are in dispute, defendant GM will herein review what it considers to be the more significant portions of Neill's testimony and will point out wherein the same fails to raise any real issues of material fact.

At the outset it should be noted that Neill was a biased witness as his name appears as one of the assignees of a partial interest in the patent in suit (R. 68). Nowhere does it appear that he has had any experience in the field of automobile engine systems and his qualifications as an expert in the field of the patent in suit are highly questionable. He testified at length on the question of anticipation yet admitted that he was only "slightly familiar" with the Hanks patent (Nov. 8 Tr. 34). He further conceded that he was not an expert and could not interpret the Hanks patent (Nov. 8 Tr. 42). On cross examination Neill was exceedingly argumentative and evasive to the point where the court had to admonish him either to answer the questions put to him or get down off the witness stand (Nov. 8 Tr. 47).

In substance, Neill testified that two of the elements of claim 6 of the patent in suit are not disclosed in the Hanks patent. These elements are a pipe connecting the inlet port with the crankcase and a flow-control valve in this pipe (Nov. 8 Tr. 38). In support of his position as to the first element, the witness argued that Hanks described his pipe as connecting to the oil sump rather than the crankcase. This argument is specious inasmuch as the oil sump of an engine is located at the bottom of the crankcase. Neill admitted that Hanks teaches the re-

covery of vapors, not oil (Nov. 8 Tr. 42), and finally conceded:

“Whether you want to call a sump a crankcase or whether you want to say a pan, that the pan on the engine of an automobile is a crankcase is a matter of conjecture.” (Nov. 8 Tr. 41).

As to the presence or absence of a flow-control valve in the Hanks patent, after considerable evasion Neill ultimately admitted on cross examination that this element was described in the Hanks patent (Nov. 8 Tr. 47).

Thus, the sum total of plaintiff's attempt to show material issues of fact regarding the defense of anticipation by Hanks consisted of the biased testimony of a witness of questionable qualification who admitted he was only slightly familiar with the Hanks patent, could not interpret it and finally on cross examination reversed the position he had taken on direct and in substance admitted that all of the elements of claim 6 of the patent in suit are described in the Hanks patent.

C. The Absence of an Issue of Material Fact

As noted above, plaintiff has done no more in his brief than assert that issues of fact exist. He has made no real effort to identify the issues or to indicate any evidence he is prepared to introduce which might tend to disprove any of the material facts established by defendant GM. This is not enough to defeat a motion for summary judgment. As stated in *3 Barron and Holtzoff Federal Practice and Procedure* 141:

“On the other hand, the whole purpose of the summary judgment procedure would be defeated if

a case could be forced to trial by a mere assertion that an issue exists, without any showing of evidence.”

This rule has frequently been recognized by this Court in upholding the granting of motions for summary judgment because of the failure of the opposing party to establish on the record that a genuine issue of material fact exists. See for example *Englehard Industries, Inc. v. Research Instrumental Corp.* (C.A. 9, 1963) 324 F.2d 347 wherein the only thing in the record opposing the showing of the moving party were affidavits containing only hearsay and legal conclusions. See also *Rankin v. King* (C.A. 9, 1959) 272 F.2d 254; *Gifford v. Travelers Protective Ass'n of America* (C.A. 9, 1946) 153 F.2d 209; *Leishman v. Radio Condenser Co.* (C.A. 9, 1948) 167 F.2d 890; *Bruce Construction Corporation v. United States* (C.A. 5, 1957) 242 F.2d 873.

As an apparent substitute for his failure to make any showing of any honest dispute as to any material fact, plaintiff relies upon two “strong presumptions” which he argues should be applied in his favor (Appellant’s Br. 6). The first of these presumptions is that the patent in suit is valid. The short answer to this is that neither the earlier device of defendant GM on which the defense of public use and sale is based nor the earlier Hanks patent on which the defense of anticipation is based was before the Patent Office in the course of the prosecution of the patent in suit. As stated by this Court in *Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp.* (C.A. 9, 1961) 287 F.2d 228, 229:

“When the most pertinent art has not been brought to the attention of the administrative body the presumption is largely dissipated.”

The second presumption urged by plaintiff is the “presumption against a summary judgment.” The answer to this is simply that there is no such presumption. As stated in *3 Barron and Holtzoff Federal Practice and Procedure* 149:

“The rationale of these cases seems to be that the moving party has the burden of showing that there is no genuine issue as to a material fact and that he is entitled to judgment as a matter of law, but that when he has made a prima facie showing to this effect the opposing party cannot defeat a motion for summary judgment and require a trial by a bare contention that an issue of fact exists. He must show that evidence is available which would justify a trial of the issue.”

Next, plaintiff appears to argue that it is improper for a court to construe a patent specification or its claims in determining a motion for summary judgment involving the validity of a patent. This is simply not the law. See for example *Milcor Steel Co. v. George A. Fuller Co.* (U.S. 1941) 316 U.S. 143, 86 L.Ed. 1332; *Rankin v. King* (C.A. 9, 1959) 272 F.2d 254; *Bulldog Electric Products Co. v. Cole Electric Products Co.* (C.A. 2, 1945) 148 F.2d 792. See also *Englehard Industries, Inc. v. Research Instrumental Corp.* (C.A. 9, 1963) 324 F.2d 347 wherein this Court upheld a summary judgment based on a lack of infringement the determination of

which required construction and interpretation of the patent involved.

Plaintiff relies upon this Court's decision in *Cee-Bee Chemical Co. v. Delco Chemicals* (C.A. 9, 1959) 263 F.2d 150. In that case the Court simply reversed a summary judgment of invalidity for the reason that the record showed the presence of a direct dispute as to a material fact. No such dispute appears in the Record of the instant case.

On pages 9 through 12 of his brief plaintiff cites several authorities and argues at length concerning various factual issues which may arise in patent cases involving the question of "obviousness" under Title 35 U.S.C. Section 103. In this, plaintiff misconstrues the nature of the two defenses sustained below which are not based upon Section 103 but rather upon Section 102(b). Whether or not plaintiff's purported invention was "obvious" is not before the Court on this appeal.

Similarly, plaintiff's arguments as to "Public Policy" and "Justice" (Appellant's Br. 7, 8) are not pertinent. Claim 6 is invalid under the unequivocal language of Section 102(b).

CONCLUSION

Claim 6 of the patent in suit is invalid because defendant GM's accused devices were sold more than a year prior to the filing of plaintiff's application. Claim 6 is also invalid because it is anticipated by the prior Hanks patent. There is no genuine issue of any material fact upon which these two defenses are based. The judgment of the court below should be affirmed.

Respectfully submitted,

LYON & LYON

By RICHARD E. LYON

Attorneys for Appellee

Of Counsel:

J. L. CARPENTER

CERTIFICATE

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit and that, in my opinion, the foregoing brief is in full compliance with those rules.

RICHARD E. LYON

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May 7, 1963

R. A. HENDERSON

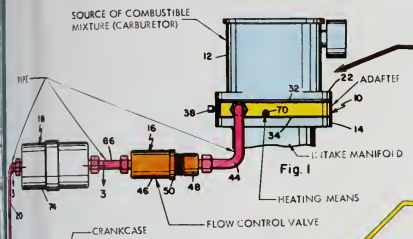
3,088,447

HENDERSON CLAIM 6

Filed Dec. 5, 1961

CONTROL FOR AUTOMOTIVE EXHAUST AIR POLLUTION

GENERAL MOTORS CRANKCASE VENTILATION SYSTEM



IN COMBINATION WITH AN INTERNAL COMBUSTION ENGINE HAVING A CRANKCASE, A SOURCE OF COMBUSTIBLE MIXTURE AND AN INTAKE MANIFOLD TO SUPPLY THE MIXTURE TO THE ENGINE;

MEANS FOR REDUCING THE AIR POLLUTANT PRODUCTS OF THE ENGINE, COMPRISING:

AN ADAPTER MOUNTED BETWEEN SAID SOURCE OF COMBUSTIBLE MIXTURE AND SAID INTAKE MANIFOLD AND HAVING

AN OPENING THROUGH WHICH THE COMBUSTIBLE MIXTURE PASSES;

AN INLET PORT IN SAID OPENING;

A PIPE CONNECTING SAID INLET PORT WITH SAID CRANKCASE TO CONDUCT CRANKCASE VAPORS INTO SAID OPENING;

A FLOW CONTROL VALVE IN SAID PIPE OPERABLE BY ENGINE INDUCED VACUUM TO CONTROL FLOW OF CRANKCASE VAPORS ACCORDING TO ENGINE SPEED AND

HEATING MEANS IN SAID ADAPTER ADJACENT SAID OPENING.

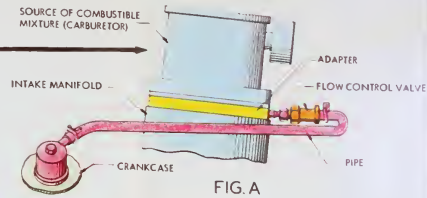


FIG. A

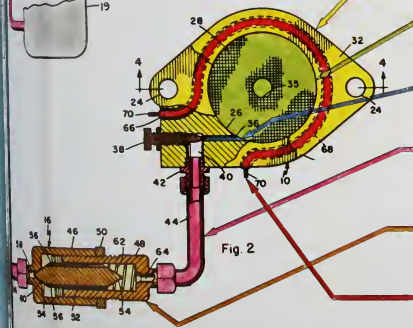


Fig. 2

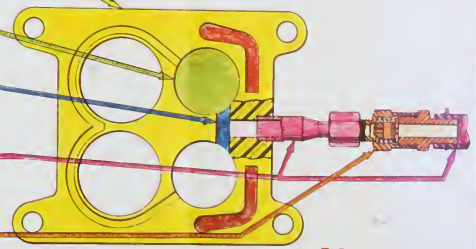


FIG. B

NOT PRESENT

